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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,027	06/19/2003	Marc Odlich	018158-011140US	5696
20350 7590 11/12/2009 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER				
SHAY, DAVID M				
ART UNIT		PAPER NUMBER		
3769				
MAIL DATE		DELIVERY MODE		
11/12/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/600,027

Applicant(s)

ODRICH ET AL.

Examiner

david shay

Art Unit

3769

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on December 5, 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

This action is in response to the Decision by the Board of Appeal rendered May 21, 2008, and the decision on rehearing rendered October 30, 2008 and in view of the amendment submitted by appellant December 5, 2008. The Board of Appeals reversed the Examiner's rejection under 35 U.S.C. 112, first paragraph of claims 1-9 based on an inadequate written description, and affirmed the rejection under 35 U.S.C. 103(a) of claims 10-15. On rehearing, the status of the claims was unaltered, and in response appellant cancelled rejected claims 10-15. The examiner had not rejected claims 1-9 under 35 U.S.C. 103(a), reasoning that claims which were not enabled based on the knowledge of one of ordinary skill in the art, would similarly not be obvious based such knowledge. The claims having been determined to be supported by the originally filed disclosure, given their breadth, as set forth in the decision by the Board of Appeals, rendered May 21, 2008, these claims are now open to an obviousness inquiry.

On appeal claim 10 read:

10. A system for treating a cornea of an eye of a patient to mitigate presbyopia with a multifocal ablation shape, the eye having a pupil and a cornea, the system comprising:

- a laser for making a beam of an ablative light energy;
- a processor in electrical communication with the laser; and
- a tangible medium coupled to the processor and having stored instructions that, if executed by the processor, will cause the processor to perform operations comprising:

- controlling a distribution of a series of laser beam pulses to ablate the multifocal shape on the eye, the multifocal ablation shape producing a first region of the cornea providing a near vision correction and a second region of the cornea providing a far vision correction; and,

determining the distribution of laser beam pulses to ablate the first and second regions of the multifocal ablation shape, where the distribution is determined in response to a signal related to a size of the pupil so as to balance the near vision correction and the far vision correction of the multifocal treatment for the patient.

This claim was ruled as obvious to one of ordinary skill in the art, based on the combination of Frey in combination with Largent. Specifically, the Board noted that “Frey discloses that, because it reshapes the cornea according to the diameter of a patient’s dilated pupil, its system advantageously avoids the problem of hazy, blurred vision and halos that can occur in vision correcting laser surgery...Because the cornea shaping apparatus processes input regarding pupil size from the pupil measuring apparatus, and because Frey’s system has a pupil-size dependent corneal sculpting program that directs the cornea shaping apparatus, we agree with the Examiner that Frey’s system meets claim 10’s limitation requiring the system to have a processor and tangible medium with instructions directing laser pulses to the patient’s pupil size.” (see the Decision on Appeal, rendered May 21, 2008, page 15). Continuing, the Board held that while Frey did not discuss providing a multifocal shape, that “Largent discloses that it is desirable to use ablative laser energy to reshape a patient’s cornea to have one region shaped to correct near vision and another region shaped to correct far vision...A person of ordinary skill would therefore have been prompted by Largent to include in Frey’s system instructions directing the processor to determine the distribution of the laser’s pulses so as to provide separate regions on the cornea to correct near and far vision as recited in claim 10.” (see the Decision on Appeal, rendered May 21, 2008, page 16).

Turing now to the limitations of claim instant claim 1, we find:

1. A method of treating a cornea of an eye of a patient to mitigate presbyopia, the eye having a pupil and a cornea, the method comprising:

identifying a multifocal ablation shape having a first region providing a near vision correction and a second region having a far vision correction;

adjusting an ablation cut profile of the multifocal ablation shape in response to the size of the pupil so as to provide a balance of the near vision correction provided by the first region and the far vision correction provided by the second region for the patient;

ablating the eye with a series of laser beam pulses according to the adjusted ablation cut profile.

Comparing the limitations of claim 1 and claim 10, we find that the “identifying a multifocal ablation shape...” is inherent in the operation of the function imparted to the processor in claim 10 by dint of the tangible medium, since if the shape were not identified, the function of “determining the distribution of pulses to produce the shape...” could never be implemented. Similarly, the step of “adjusting the ablation cut profile...to the size of the pupil...” is also included in the “determining...” step since this is done “...in response to a signal related to a size of the pupil...”. Clearly usage of the system of claim 10 for its intended purpose will result in the “ablating...” step.

Therefore, it is clear that, in view of the broad construction of claims 1-9, with which the Board has enlightened the examiner through their Decision rendered May 21, 2008, the subject matter of these claims falls under the teachings set forth by the combination of Frey and Largent.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frey in combination with Largent. Frey teaches a laser surgical system including a laser and a processor and scaling the ablation to the pupil size (see column 1, lines 5-10 and column 2, lines 46-55). Largent teaches designing a corneal ablation to mitigate presbyopia. It would have been obvious to the artisan of ordinary skill to employ the device of Frey on a subject with presbyopia, since this condition is correctable with laser sculpture as taught by Largent, or to employ the pupil scaling device of Frey in the presbyopia treating system of Largent, since this would reduce the halo effect and improve night vision, as taught by Frey, thus producing a device such as claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Monday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Johnson, can be reached on Monday through Friday from 7:00 a.m. to 3:30 p.m. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private

PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/david shay/

Primary Examiner, Art Unit 3769

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth above by signing below:

/DONALD T HAJEC/

Director, Technology Center 3700